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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,406

11/23/2005

Christelle Pragnon

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EXAMINER

MARTIN, PAUL C

ART UNIT

PAPER NUMBER

1657

MAIL DATE

DELIVERY MODE

08/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,406	Applicant(s) PRAGNON ET AL.	
	Examiner Paul C. Martin	Art Unit 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/17/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-3 and 5-13 are pending in this application and were examined on their merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The objection to the drawings under 37 CFR 1.83(a) for failing to show any lines or graphs indicating actin polymerization as described in the specification has been withdrawn due to the Applicant's submission of replacement drawings on 05/17/07.

The objection to the Specification for use of the word "tampon" on place of "solution" or "buffer" has been withdrawn due to the Applicant's amendments to the Specification filed 05/17/07.

The information disclosure statement (IDS) submitted on 05/17/07 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

The rejection of Claims 6-12 under 35 U.S.C. § 112, 2nd paragraph as being indefinite for failing to point out and distinctly claim the subject matter which Applicant's regard as their invention, has been withdrawn due to the Applicant's amendments to the Claims filed 05/17/07.

The rejection of Claims 1, 2 and 6 under 35 U.S.C. § 102(b) as being anticipated by Tellam *et al.* (1986) has been withdrawn due to the Applicant's amendments to the Claims file 05/17/07.

The rejection of Claims 1-3, 8 and 9 under 35 U.S.C. § 102(b) as being anticipated by Malicka-Blaszkiwicz *et al.* (1995) has been withdrawn due to the Applicant's amendments to the Claims file 05/17/07.

The rejection of Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Tellam *et al.* (1986) in view of Menu *et al.* (2002) has been withdrawn due to the Applicant's amendments to the Claims file 05/17/07.

The rejection of Claims 1-3 and 8-11 under 35 U.S.C. § 103(a) as being unpatentable over Malicka-Blaszkiwicz *et al.* (1995) has been withdrawn due to the Applicant's amendments to the Claims file 05/17/07.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

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The disclosure is objected to because of the following informalities: The disclosure improperly references Claims, including canceled claim 4 at Paragraph [00039]. Appropriate correction is required.

The use of the trademarks Beacon™ and GraphPad Prism™ has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6-13 are newly rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Amended Claims 6 and 12 contain the new limitation requiring the addition of subunits selected from the group consisting of the Arp2/3 complex and the Ena/VASP family of proteins and a kit comprising subunits of the Arp2/3 complex and the Ena/VASP family of proteins. Support for this step and kit is not found in the instant disclosure which only teaches the Arp2/3 complex and the Ena/VASP family of proteins in a general fashion, see Specification Paragraphs [0006]-[0008] and [00022], and does not specifically teach the step of addition of either of these compounds in order to activate endogenous actin polymerization or a kit comprising said subunits. Claims 7-13 are rejected as being dependent upon rejected Claim 6. THIS IS A NEW MATTER REJECTION.

Claims 8-11 remain rejected under 35 U.S.C. § 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reasons of record set forth in the Action mailed 11/17/06.

Claim Rejections - 35 USC § 103

Claims 1-3 and 5-8 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Tellam *et al.* (1986) in view of Menu *et al.* (2002) for reasons of record set forth in the Action mailed 11/17/06.

Response to Arguments

Applicant's arguments filed 05/17/07 have been fully considered but they are not persuasive.

The Applicant argues that neither Tellam *et al.* nor Menu *et al.* relate to the measurement of endogenous acting polymerization, that Tellam *et al.* describes the measurement of skeletal muscle actin not endogenous actin, and that the techniques used by Tellam *et al.* and Menu *et al.* are limited to fluorescence microscopy, confocal laser scanning microscopy, fluorometry and flow cytometric analysis, not static fluorescence polarization and that the use thereof would not have been obvious to one of ordinary skill in the art at the time of the invention (Remarks, Pg. 11, Lines 8-22).

The Applicant's arguments are not found to be persuasive for the following reasons, while the method of Tellam *et al.* is directed to the measure of exogenous skeletal muscle actin, Tellam *et al.* teaches that the higher actin nucleating activity seen in tumorigenic cells results from the lower level of total endogenous cellular actin within the tumorigenic cells (Pg. 1287, Lines 7-12).

Therefore, one of ordinary skill in the art would have recognized that the authors were aware of the differences in actin polymerization between tumorigenic cells and non-tumourigenic cells and the adaptation of the method of Tellam *et al.* from an exogenous assay of actin polymerization to endogenous actin polymerization would have been obvious to one of ordinary skill in the art at the time of the invention. Further, the rejection was based upon the combination of Tellam *et al.* and Menu *et al.* wherein Menu *et al.* is directed to the measurement of polymerized endogenous F-actin, no extraneous actin being added in the method.

Further, the Applicant's arguments regarding the use of static fluorescence polarization are not found to be persuasive, because as the Applicant's specification teaches, "The measurement of the quantity of actin in the steady state can be accomplished by any technique known to a person skilled in the art, such as, for example, the static fluorescence polarization technique, also known as static fluorescence anisotropy" and that "anisotropy and polarization are two values related mathematically, and thus easily interchanged. They describe the same phenomenon" [00026].

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The Applicant's explanation of fluorescence polarization (anisotropy), while appreciated, do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited, i.e., the measurement of endogenous F-actin using fluorescence anisotropy (polarization) as taught by Menu *et al.* previously and why one of ordinary skill in the art would not have been motivated to use the technique in a combined method with Tellam *et al.* for the measurement of cell lysate actin in the steady state.

Conclusion

No Claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul C. Martin whose telephone number is 571-272-3348. The examiner can normally be reached on M-F 8am-4:30pm.

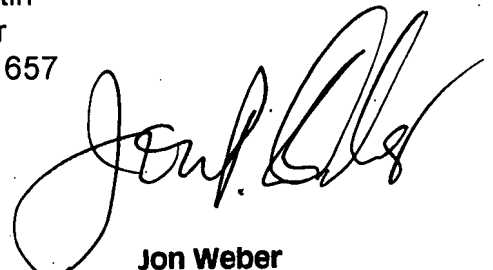
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

7/27/07

Paul Martin
Examiner
Art Unit 1657

A handwritten signature in black ink, appearing to read "Jon Weber", with a large, stylized loop at the end.

Jon Weber
Supervisory Patent Examiner